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Appl. No. 10/701,848
Response dated Oct. 16, 2006
Reply to Office Action of Aug. 16, 2006

OCT 16 2006

REMARKS

Claim 1-22 are now pending. The Examiner has rejected claims 1-22.

Claim Objections

Claims 18 is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 18 has been cancelled, and therefore the objection is moot.

Claim Rejections under 35 U.S.C. § 112

Claims 17-21 stand rejected under 35 U.S.C. § 112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 17-21 have been amended to overcome the indefiniteness rejection, and the Applicants respectfully request the withdrawal of the rejection thereof under 35 U.S.C. § 112 ¶2.

Claim Rejections under 35 U.S.C. § 102(e)

Claims 16-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Marsh et al. (U.S. Pub. 2002/0073304. Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 16 and its dependent claims (i.e., claims 17-22), amended claim 16 recites “[a] method for updating firmware or software in an electronic device having an operating system comprising a file system, the method comprising: receiving from a server

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information for updating the firmware or software; with operating system support: storing the information for updating firmware or software in a location in the file system; and saving, in a memory reference, information identifying the location in the file system of the information for updating firmware or software; and without the operating system support: accessing the information identifying the location of the information for updating firmware or software in the file system; and updating firmware or software in the electronic device employing the stored information for updating firmware or software by using the information identifying the location of the information for updating firmware or software in the file system."

Applicants respectfully submit that the cited prior art, Marsh, does not teach the claimed invention of claim 16. More specifically, for example, Marsh, fails to teach, suggest or disclose, among other things, "storing the information for updating firmware or software in a location in the file system." Instead, Marsh in Paragraph [0047] discusses delivering and installing a firmware upgrade patch to a boot disk, i.e., a fixed data storage device. However, there is no indication or discussion in Marsh that the upgrade patch is stored in a location in a file system.

Therefore, Applicants respectfully submit that the Marsh reference fails to anticipate Applicants' claim 16, for at least the reasons given above. Claim 16 is an independent claim having dependent claims 17-22. Applicants believe that claim 16 is allowable, therefore, Applicants submit that claims 17-22 are also allowable, for at least the same reasons given with respect to claim 16. Applicants therefore respectfully request that the rejection of claims 16-22 under 35 U.S.C. § 102(e) be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lajoie et al. (U.S. Pub. 2004/0015952A1) in view of Herley et al. (U.S. Pat. No. 6,948,104). Applicants respectfully traverse the rejection.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met, one of which is that the

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reference or combination of references must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination”, and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so’” (citing *In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F. 3d 1308, 50 USPQ 2d. 1161 (Fed Cir. 1999) is that the reference or combinations of references must teach or suggest all the claim limitations.

Regarding independent claim 1 and its dependent claims (i.e., claims 2-15), claim 1 recites “[a] system that facilitates updating of firmware in an electronic device with a file system, the system comprising: an electronic device comprising: at least one of volatile and non-volatile memory; loader software that supports a plurality of loaders, wherein, during operation, each of the plurality of loaders performs downloading of specific information for updating firmware; update software that supports retrieving the information for updating firmware in the electronic device; and communication software that administers communicating the information for updating firmware from a server.”

Applicants respectfully submit that the cited prior art, Lajoie in view of Herley, does not teach the claimed invention of amended claim 1. More specifically, for example, Lajoie fails to teach, suggest or disclose, among other things, “a file system” as asserted by the Examiner. In fact, nowhere in Lajoie is a “file system” mentioned. Additionally, Lajoie fails to teach, suggest or disclose, among other things software that downloads information for updating firmware. Instead, Lajoie discloses an upgrading process by copying the entire application program from the server to the memory, there is no discussion of downloader software. Furthermore, Lajoie fails to teach, suggest or disclose, among other things an “update software that supports retrieving information for updating firmware” that has been already downloaded on the

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electronic device. Instead, and following the Examiner's reasoning that the Application Program is equivalent to the information for updating firmware, Lajoie discloses an upgrade program that retrieves upgrade information from the server to upgrade itself, and the application program is then copied from the server, without the involvement of the upgrade program. (Lajoie, Paragraph [0035]).

Therefore, Applicants respectfully submit that the Lajoie in view of Herley fails to anticipate Applicants' claim 1, for at least the reasons given above. Claim 1 is an independent claim having dependent claims 2-15. Applicants believe that independent claim 1 is allowable, therefore, Applicants respectfully submit that claims 2-15 are also allowable for at least the same reasons given with respect to claim 1. Applicants therefore request that the rejection of claims 1-15 under 35 U.S.C. § 103(a) be withdrawn.

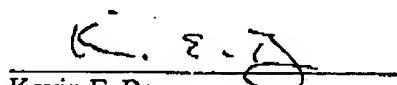
Applicants believe that all claims 1-22 are in condition for allowance. If Examiner disagrees or has any questions regarding this submission, Applicants invite Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

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Respectfully submitted,


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